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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,002	10/18/1999	MARC A. COHEN		2196

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EXAMINER

HOOSAIN, ALLAN

ART UNIT PAPER NUMBER

2645

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

TM

Office Action Summary

Application No.

09/420,002

Applicant(s)

COHEN ET AL. 

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13,16,17 and 20 recite the limitation "the Internet" in line 1 respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregorek et al.** (US 5,557,658) in view of **Wynblatt et al.** (US 6,018,770).

As to Claim 13, with respect to Figures 11A-11B, Gregorek teaches a method of direct advertising over a network (the Internet), comprising:

applying a subscription list (first database) of information at a marketing site (web site) (Figure 11A, label 174);

applying a menuing system (second database) having a multiplicity of attributes which are unique to a given individual (Figure 11A, labels 178,180),

applying an area listing (third database) of a plurality of advertising messages that are transmittable over the network (internet) (Figure 11A, label 182),

linking the first, second and third databases to the marketing system (web site), receiving a visit to the marketing system (web site) over the network (internet) from an individual (Figure 11 A, label 170),

determining the identity of the individual in the second database, culling attributes for the individual from the second database based on their identity (Figure 11a, label 176),

selecting a message based on the culled attributes (Figure 11A, label 182),

transmitting the selected message to the consumer over the network (internet) (Figure 11B, label 186), and

transferring the information to the consumer over the network (internet) (Figure 11B, label 186);

Gregorek does not teach the following limitations:

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“Internet” and “web site”

However, it is obvious that **Gregorek** suggests the limitations. This is because **Gregorek** teaches the network could be any communication network that processes any type of media (Col. 6, lines 25-55). **Wynblatt** teaches the Internet and web sites for allowing advertisers to send information to subscribers (Col. 7, line 66 through Col. 8, line 11). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add Internet and web site capabilities to **Gregorek**'s invention for processing advertisements as taught by **Wynblatt**'s invention in order to provide subscribers with alternate dial tone services.

As to Claims 14-15,18-19,21-22, **Gregorek** teaches a method of directed advertising over the internet as claimed in claim 13 further comprising:

(i) selecting an additional advertising message based on the culled attributes (figure 11A, label 186),

(ii) transmitting the additional advertising message to the consumer over the network (internet),

(iii) transferring additional information to the consumer over the network (internet),
and

(iv) repeating steps (i)-(iii) (Figure 11B);

Gregorek does not teach the following limitation:

“Internet”

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However, it is obvious that **Gregorek** suggests the limitations. This is because **Gregorek** teaches the network could be any communication network that processes any type of media (Col. 6, lines 25-55). **Wynblatt** teaches the Internet for allowing advertisers to send information to subscribers (Col. 7, line 66 through Col. 8, line 11). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add Internet capability to **Gregorek's** invention for processing advertisements as taught by **Wynblatt's** invention in order to provide subscribers with alternate dial tone services.

As to Claims 16-17,20, with respect to Figures 11A-11B, **Gregorek** teaches a method of making offers over a network (the internet), comprising:

- creating a first database of information at a marketing system (web site) (Figure 11A, label 174),

- creating a second database of demographic information having a multiplicity of attributes for each of a plurality of individuals, each individually having an identity (Figure 11A, label 178,180),

- creating a third database of a plurality of advertising messages that are transmittable over the network (internet) (Figure 11A, label 182),

- the third database further including a vendor link for contacting over the internet a vendor sponsoring the advertising message (Figure 11 A, label 170 and Figure 5),

- linking the first, second and third databases to the marketing system (web site) (Figure 11a, label 170),

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receiving a visit to the marketing system (web site) over the network (internet) from an individual (Figure 11A, label 170),

determining the identity of the individual in the second database (Figure 11A, label 176),

culling attributes for the individual from the second database based on their identity (Figure 11A, labels 180,182),

selecting an advertising message based on the culled attributes (Figure 11B, label 186),

transmitting the selected message to the consumer over the network (internet) (Figure 11B, label 186),

transferring the information to the consumer over the network (internet) Figure 11B, label 186),

transmitting the vendor link over the network (internet) (Figure 8, label 92), and

connecting the consumer to the vendor when the consumer activates the vendor link (Figure 8, label 92 and Col. 14, lines 5-26);

Gregorek does not teach the following limitations:

“Internet” and “web site”

However, it is obvious that **Gregorek** suggests the limitations. This is because **Gregorek** teaches the network could be any communication network that processes any type of media (Col. 6, lines 25-55). **Wynblatt** teaches the Internet and web sites for allowing advertisers to send information to subscribers (Col. 7, line 66 through Col. 8, line 11). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art

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to add Internet and web site capabilities to **Gregorek's** invention for processing advertisements as taught by **Wynblatt's** invention in order to provide subscribers with alternate dial tone services.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Logan et al. (US 5,721,827) teach a subscriber device which permits retrieving information over the Internet.

Sonesh et al. (US 6,046,762) teach a call routing system which permits queued callers to browse information over the Internet.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Allan Hoosain
Primary Examiner
1/27/03